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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,508	05/10/2001	Roland Cherif Cherif Cheikh	BET01/0233	2278

466 7590 03/09/2004

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EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 03/09/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,508

Applicant(s)

CHERIF CHEIKH ET AL.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-47 and 49-89 is/are pending in the application.
- 4a) Of the above claim(s) 56,58-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-47,49-55,57 and 87-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The 112 Rejection is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 45, 46, 47, 49, 50, 51, 52, 87, 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamashita (55-7352).

Yamashita discloses a syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing (13) which houses said element forming the reservoir. (Figures 1, 4 and 5 and entire reference).

As to claim 45, wherein said element forming the reservoir provides mechanical resistance of the syringe. (Figures 1, 4, 5 and entire reference).

4. Claims 45, 46, 49, 50, 51, and 87-89 are rejected under 35 U.S.C. 102(b) as being anticipated by Threlfall (USPN 368627).

Threlfall discloses a syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support

or casing which houses said element forming the reservoir (Figures 1, 2 and entire reference).

5. Claims 45 -47, 49, 50, 51, 57, 87 and 88 are rejected under 35 U.S.C. 102(e) as being anticipated by Higashikawa (USPN 5704918).

Higashikawa discloses syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing which houses said element forming the reservoir. (Figures 11, 12, 13, and entire reference)

6. Claim 89 is rejected under 35 U.S.C. 102(e) as being anticipated by Park (USPN 6475193).

Park discloses a syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing which houses said element forming the reservoir. (Figures 2, 3, 4, 5, and entire reference)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 45-47, 49-55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita as applied to claims 45 –47, 49, 50, 52 above, and further in view of Higashikawa.

With regard to claims 45-47, 49 – 55, Yamashita meets the claim limitations as described above but fails to include the claimed dimensions. At the time of the invention, it would have been obvious to construct the device from the claimed dimensions since the Federal Circuit has held, where the only difference between the prior art and the claims was a recitation of relative dimension/size/proportion of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

With regard to claim 57;

Yamashita disclosed the claimed invention but fails to disclose wherein the tubular reservoir has more than two tubes.

Higashikawa disclosed an adjustable dispensing syringe with an outer cast, and two inner tubes that form inside the reservoir.

At the time of the invention it would have been obvious for a person of ordinary skill in the art to combine the disclosed invention of Yamashita with the teachings of Higashikawa because it is well known in the art to use two tubes when combining different agents being injected into the body, especially when one agent is a liquid and the other agent is a solid material.

Response to Arguments

9. Applicant's arguments filed 1/6/04 have been fully considered but they are not persuasive.

10. With regards to Yamashita (JP-55-73352), the casing member 13 and this provides axially forces on said reservoir as well as provides virtually zero clearance with said reservoir.

11. With regards to Threlfall discloses the claimed invention, the applicant argues that Threlfall does not teach the casing forms a peripheral shell, and that there is virtually zero clearance, this is taught in reference letter g in Figures 1 and 2. The term "virtually" broadens the interpretation of the claimed structure and therefore the examiner believes that prior art teaches that aspect of the claimed invention. The applicant also argues that the casing member doesn't strengthen the reservoir against pressure, the examiner disagrees because the casing member has threads which are used to tighten and secure the syringe in place, therefore the structure of the prior art is capable of performing that function.

12. With regards to Higashikawa, the examiner withdraws claim 89 from the rejection because the housing does not surround the entire reservoir. The examiner still keeps the rest of the rejection. Higashikawa discloses a reservoir in Figures 11 and 12 as the space between the casing member (302) and the piston (312). The needle has a base, which is reference numbers (305, 307). The examiner is interpreting "fastened" as attached according to Merriam-Webster Online Dictionary by Merriam-Webster, Incorporated.

13. With regards to Park, the examiner withdraws claims 45-47, 49-52, 87, and 88 because the base of the needle does not come into connect with the reservoir. Claim 89 is still rejection because the housing (10) does surround the entire reservoir (2). The needle is also fixedly engaged between the housing and the reservoir; this can be seen in Figure 3.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

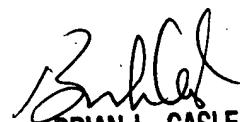
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
Art Unit 3763
March 8, 2004



BRIAN L. CASLER
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